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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,565	09/30/2003	James F. Brown	3654-011-02	3838

35411 7590 01/05/2007  
KILYK & BOWERSOX, P.L.L.C.  
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FAIRFAX, VA 22030

EXAMINER
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NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/674,565

Applicant(s)

BROWN, JAMES F.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10/2/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 14 and 32-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-13 and 15-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/2/06
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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1. Applicant's election without traverse of group I, claims 1, 3-13, and 15-31 and the species of acrylate, furfuryl-containing ring, and compounds having a furfuryl ring and an acrylate reactive group which species read on claims 1, 3, 5-13, and 15-31 in the reply filed on 4/20/06 is acknowledged.

2. The references of page 4 of the IDS of 12/1/03 were not supplied with the instant application and are not readily available to the examiner, with the exception of the single initialed reference. They were therefore not considered.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3, 5-13, and 15-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28-32 of U.S. Patent No. 5853894 Brown in view of the Sartomer Bulletin regarding CD611 printed 8/4/03 and supplied by the applicant.

Claims 28-32 of Brown, particularly the functional acrylate monomers of claim 32 of Brown encompass the instantly claimed composition broadly except that the instantly claimed species of adhesion promoter is not claimed. It is not seen that the instantly claimed adhesion promoters are disclosed by the CIPs and DIVs from which the instant application claims benefit. The Sartomer bulletin is therefore prior art with respect to the use of the instantly claimed adhesion promoters. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the alkoxyated tetrahydrofurfuryl acrylate of the Sartomer bulletin as the functional acrylate of Brown because Brown encompasses such functional acrylates and they would have been expected to give the intercoat adhesion, i.e. adhesion promotion, described in the Sartomer bulletin.

5. Claims 1, 3, 5-13, and 15-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28-32 of U.S. Patent No. 6495624 Brown in view of the Sartomer Bulletin regarding CD611 printed 8/4/03 and supplied by the applicant.

Claims 1-48 and 58-60 of Brown, particularly the acrylics of claims 22 and 41 of Brown encompass the instantly claimed composition broadly except that the instantly claimed species of adhesion promoter is not claimed. It is not seen that the instantly claimed adhesion promoters are disclosed by the CIPs and DIVs from which the instant application claims benefit. The Sartomer bulletin is therefore prior art with respect to the use of the instantly claimed adhesion promoters. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the alkoxyated tetrahydrofurfuryl acrylate of the Sartomer bulletin as the acrylic resins of Brown because Brown encompasses such acrylics and they would have been

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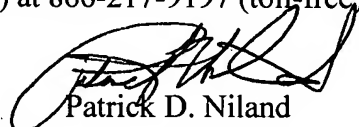
expected to give the intercoat adhesion, i.e. adhesion promotion, described in the Sartomer bulletin.

6. The PTO has received the terminal disclaimer of 10/2/06. The division which considers these papers has not acted on the terminal disclaimer as of yet but the office requires the examiner to act on this case now. The rejections above are maintained awaiting the office's decision on the applicant's terminal disclaimer.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrick D. Niland  
Primary Examiner  
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